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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,026	11/17/2003	Hidehiko Kanda	CFA00049US	5575

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EXAMINER

GARCIA JR, RENE

ART UNIT PAPER NUMBER

2853

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,026	Applicant(s) KANDA ET AL.	
	Examiner Rene Garcia, Jr.	Art Unit 2853	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 206. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: paragraph 0034 refers to reference 206 in fig. 5; perhaps mean reference 208.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook et al. (US PGPUB 2002/0080396).

Silverbrook et al. discloses the following claimed limitations:

*regarding claim 1, a method for recording, on one recording medium/**netpage, 1/** (fig. 1; paragraph 0216), a positional information image/**coded data, 3/** representing positional information (paragraph 0158; x & y coordinates) corresponding to at least positions on the recording medium/**1/** and the other image/**graphic data, 2/**, using a recording apparatus/**netpage printer, 601/** (fig. 11) that applies a recording material/**inks/** (paragraph 0243) onto the recording medium/**1/**, the method comprising:

*step of obtaining information on recording of the positional information image/**coded data, 3/** according to record data for recording the positional information image/**3/** (fig. 1; paragraph 0562 & fig. 52 – main processor has received/obtained/ document's page layouts/record data/ [page layouts include positional data for the image])

*correction step of correcting record data of said the other image/**graphic data, 2/** so that a predetermined recording property of said the other image/**2/** is varied, according to the obtained information (paragraphs 0569 & 0571 – halftoner/compositor and custom tag encoder does conversion based on information from main processor/750/)

*recording step of recording the positional information image/**coded data, 3/** and said the other image/**graphic data, 2/** corrected, on the recording medium/**netpage, 1/** (fig. 1, paragraph 0129; paragraph 0220)

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*regarding claim 2, predetermined recording property is density, and the density of said the other image/**graphic data, 2/** is reduced in the correction step (paragraph 0571; dither is used to reduce density)

*regarding claims 3 and 8, information on recording of the positional information image/**coded data, 2/** is recording duty in a region where the positional information image/**2/** is recorded (fig. 1; paragraphs 0148, 0220, 0155, 0562, 0565 –netpage tag/recoding duty/ makes up the invisible ink/recording material/ to be printed in a region [tags/**4/** contain the positional information])

*regarding claim 4, in the recording step, the positional information image/**coded data, 3/** is recorded with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and said the other image/**graphic data, 2/** is recorded with a recording material/**inks/** (paragraph 0243; cyan, magenta, yellow, black) incapable of being detected by the detector/**netpage pen, 101/** (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*regarding claim 5, recording material/**infrared inks, IR-absorptive black ink/** for recording the positional information image/**coded data, 3/** (fig. 1) contains carbon black (paragraphs 0584 – 0592; infrared dyes/ink/ contain carbon atoms)

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*regarding claim 6, recording system (fig. 14) comprising:

*recording apparatus/**netpage printer, 601/** (fig. 11) for perform recording by applying a recording material/**ink/** onto a recording medium/**netpage, 1/** according to image data/**graphic data, 2/** (fig. 1)

*transmitter/**IEEE 1394 Serial Interface, 659/** (fig. 14, paragraph 0569) for transmitting the image data to the recording apparatus/**601/**

*preparation means/**print engine controller, 760/** for preparing image data corresponding to an image to be recorded (fig. 16; paragraph 0567)

*acquisition means/**controlling processor, 750/** (paragraphs 0552, 0553 & 0562) for obtaining information on recording of a positional information image/**coded data, 3/** (fig. 1), according to record data for recording the positional information image/**3/**, the positional information image/**3/** representing positional information corresponding to positions(paragraph 0158; x & y coordinates) on the recording medium/**netpage, 1/(**figs. 8 & 9)

*correction means/**halftoner/compositor unit, 765/** (fig. 16) for correcting record data for recording said the other image according to the information obtained by the acquisition means, wherein the recording apparatus/**601/** records the positional information image/**3/** and said the other image/**2/** corrected by the correction means, on one recording medium/**1/** (paragraph 0567 & 0567)

*regarding claim 7, correction means/**halftoner/compositor unit, 765/** (fig. 16) corrects the image data to reduce density (paragraph 0571; dither is used to reduce density)

*regarding claim 9, positional information image/**coded data, 3/** (fig. 1) is recorded with a recording material/**infrared inks, IR-absorptive black ink/** capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), said the other image/**graphic data, 2/** is recorded with a recording material/**inks/** (paragraph 0243; cyan, magenta, yellow, black) incapable of being detected by the detector/**netpage pen, 101/** (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting), and the recording material for recording the positional information image contains carbon black (paragraphs 0584 – 0592; infrared dyes/ink/ contain carbon atoms)

*regarding claim 10, recording apparatus/**netpage printer, 601/** for forming an image on a recording medium, comprising:

*recording means/**print engine controllers, 760/** (fig. 14; paragraph 0554) for performing recording by applying a recording material/**ink/** onto the recording medium/**netpage, 1/**, the recording means/**760/** recording at least one of a positional information image representing positional information corresponding to the position (paragraph 0158; x & y coordinates) where the positional information image/**coded data, 3/** is recorded and the other image/**graphic data, 2/** (fig.1)

*control means/**controlling processor, 750/** (fig. 14; paragraphs 0552 & 0553) for controlling the recording such that the recording means records the positional information image/**coded data, 3/** with a recording material capable of being detected by a predetermined detector/**netpage pen, 101/** (figs. 8 & 9; paragraph 0255), and said the other image/**3/** with another recording material/**inks/** (paragraph 0243; cyan, magenta, yellow, black) incapable of

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being detected by the detector/**101**/ (paragraph 0151 – cyan, magenta, yellow, black are non-infrared emitting)

*correction means/**halftoner/compositor unit, 765**/ (fig. 16) for correcting record data for recording said the other image/**graphic data, 2**/, according to record data for recording the positional information image/**coded data, 3**/ (fig. 1; paragraph 0567 & 0567)

Conclusion

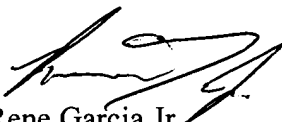
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ericson et al. (US 6,854,821) disclose printing using position-coding pattern for graphical data positioning. Lazzouni et al. (US 5,661,506) disclose a recoding system using invisible inks with positional data and the use of an imaging pen.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Garcia, Jr. whose telephone number is (571) 272-5980. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rene Garcia Jr.
30 August 2005

 9/15
K. FIGGINS
PRIMARY EXAMINER